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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/079,814 05/16/98 NEMIRE

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PM82/0116

EXAMINER

ROWAN, K

ART UNIT

PAPER NUMBER

3643

DATE MAILED:

01/16/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/079,814

Applicant(s)
NEMIRE

Examiner
Kurt Rowan

Group Art Unit
3643



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-24 is/are pending in the application.

Of the above, claim(s) 21-24 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-8, 11-16, 19, and 20 is/are rejected.

☒ Claim(s) 9, 10, 17, and 18 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-20, drawn to a fishing lure, classified in class 43, subclass 42.16.
 - II. Claims 21-22, drawn to a rattle for use with a fishing lure, classified in class 43, subclass 42.31.
 - III. Claims 23-24, drawn to a propeller for use with a fishing lure, classified in class 43, subclass 42.19.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because other lure structure is recited such as the concave and convex body surfaces . The subcombination has separate utility such as in a different fishing lure.
3. Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has

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utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because other lure structure is recited such as the concave and convex body surfaces and the rounded front and trailing ends. The subcombination has separate utility such as a propeller on another fishing lure.

4. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as a noise maker on a lure without a propeller. See MPEP § 806.05(d).

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Mr. Stoneman on Jan 8, 2000 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 21-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Drawings

7. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-5, 8, 11-12, 14-16, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adam in view of Foutch et al.

The patents to Adam and Foutch show fishing lures. Adam shows an elongate body 1 having a central axis, a concave inner surface 17 and a convex outer surface (not labeled but the side with weight 16), a rounded trailing edge 3, a rounded leading edge 2 and a hole 4. Adam shows a hook 28 which acts as a snaring means. Adam shows an attachment means 7 for attaching the fishing line 8 to the body portion and a holding means 21. Adam does not show a rattle means. The patent to Foutch shows a fishing lure 22 having a rattle means 36. In reference to claim 1, it would have been obvious to provide Adam with a rattle as shown by Foutch to attract more fish. See Foutch, column 1, lines 10-16. In reference to claim 2, Foutch shows a bracket 40 having an elongated portion 38, a top surface 42 and a curved portion 34 which is arranged to partially

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encircle the rattle means 36 as shown in Figs. 2-9. In reference to claim 3, Foutch shows a cylindrical body portion 34 having a chamber for holding at least one movable body 36. In reference to claim 4, Adam shows the leading edge 2 having a larger radius than the trailing edge 3. In reference to claim 5, Adam shows a hook 28. In reference to claim 8, Adam shows a skirt (not labeled but see Fig. 7). In reference to claims 11, 19, Adam shows an elongated wire 5 having a looped first end 7 a straight central portion and a looped second end 6. In reference to claims 12, 20, Adam shows a propeller 13-15. In reference to claim 14, Adam shows hole 4 adjacent the rounded leading edge of the lure body portion. In reference to claim 15, Adam does not disclose that the hole is at approximately 12 percent of the distance between the leading edge and the rounded trailing edge. However, it would have been obvious to locate the hole at a distance of 12 percent between the leading edge to the trailing edge since routine experimentation would be used to determine the optimum location of the hole. In reference to claim 16, see the rejections of claims 1-5, 15, above.

10. Claims 6-7, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adam and Foutch et al. as applied to claim 1 above, and further in view of Schavey.

The patents to Adam, Foutch and Schavey show fishing lures. Adam and Foutch have been discussed above. Schavey shows a lure having a holder (not labeled) for skirt 20 which has a plurality of filaments that act as a weed guard. Schavey also shows a propeller B having a flat body having a first body end and integrally attached to the first body a pair of circular propeller portions with each circular propeller having a circular inner surface and a circular outer surface as

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shown in Figs. 6-7. In reference to claims 6-7, it would have been obvious to provide the lure of Adam as modified by Foutch with a holder having a hollow upper end as shown by Schavey since merely one filament holder is being replaced with another one which is an equivalent mechanical part. In reference to claim 13, Adam shows a propeller having a cylindrical section 15 and curved blades 13-14. It would have been obvious to provide the lure of Adam as modified by Foutch with a propeller as shown by Schavey since merely one propeller is being substituted for another.

Allowable Subject Matter

11. Claims 9-10, 17-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Norton, Reed, Hood, and Link show other lures with sound making.

13.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **KURT ROWAN** whose telephone number is (703) 308-2321.

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The examiner can normally be reached on Monday-Thursday
from 6:30 a.m. to 5:00 p.m.

The fax phone number for the organization where this
application or proceeding is assigned is (703) 306-4195 or (703)
305-3597.

Any inquiry of a general nature or relating to the status of
this application or proceeding should be directed to the
receptionist whose telephone number is (703) 308-1113.

A handwritten signature in black ink, appearing to read "Kurt Rowan". The signature is written in a cursive, slightly slanted style.

KURT ROWAN

PRIMARY EXAMINER

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January 10, 2001